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#10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/059,611 04/13/98 AIHARA T FSPT-160

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EXAMINER

HAMDAN, W

ART UNIT	PAPER NUMBER
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2776

11

DATE MAILED: 04/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/059,611

Applicant(s)
Tim Aihara et al.

Examiner
Wasseem H. Hamdan

Group Art Unit
2776



☒ Responsive to communication(s) filed on Mar 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III - DETAILED ACTION

1. This office action is in response to applicant's amendment filed on 03/20/2000.
 2. In the Amendment, claim 9 is canceled. Accordingly, claims 1-8 and 10-20 are pending.
- Claims 1, 8, and 14 are independent claims.

Amendment

Suggestions:

3. On page 8, line 8 where it stated "problem solved the by", the examiner believes that the applicant meant to state "problem solved by" (the "the" need to be deleted).
4. On page 4, claim 14, line 2 of the Amendment where it stated "and a display", the examiner believes that the applicant meant to state "a display".

Claim Rejections - 35 USC § 103

5. This application currently names joint inventors. In considering patentability of the claims under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103© and potential 35 USC 102(f) or (g) prior art under 35 USC 103(a).

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6. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 10-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Molly E. Holzschlag (Laura Lemay Series Editor; Copyright 1997 by Sams. net Publishing) in view of Parulski et al. (US Patent Number 5,633,678).

With respect to independent claim 1:

Holzschlag disclose a method for generating an Internet page description file including images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose that the image is captured by a digital imaging device having a display and a computer, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer. However, Parulski et al. disclose the image is captured by a digital imaging device having a display and a computer (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the image captured by a digital imaging device, the digital imaging device having a display and a computer system in the system of Holzschlag .

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The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device having a display and a computer because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

the method comprising the steps of:

a) displaying interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 26-34);

b) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a series of related image captures to obtain a series of resulting images (page 75 - column 1: lines 19-34; column 2: lines 20-34); and

c) generating an HTML (hypertext markup language) file referencing the resulting images, wherein the HTML file is formatted in accordance with a predefined model, such that a formatted HTML file is automatically generated by the digital imaging device (page 76 - column 1: lines 1-34).

With respect to dependent claim 2:

Holzschlag disclose the step of providing the interactive instructions by externally loading a script into the digital imaging device (Page 76 - column 1: lines 1-34). Even though Holzschlag does not explicitly disclose the image digital imaging device, it is obvious that the image used by

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Holzschlag teaching needs a digital imaging device. However, Parulski et al. disclose the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the digital imaging device in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40).

With respect to dependent claim 3:

Holzschlag discloses the claimed limitations as stated in claim 1 wherein step b) further includes the step of providing the script as a text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 4:

Holzschlag discloses the claimed limitations as stated in claim 1 wherein step c) further includes the step of executing the script by the digital imaging device interpreting the text-based script (Page 75 - column 1: lines 20-34).

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With respect to dependent claim 5:

Holzschlag discloses the claimed limitations as stated in claim 1 step d) further includes the step of prompting the user for specific information, and entering the specific information on a text entry screen (page 75 - column 1: lines 25-34).

With respect to dependent claim 6:

Holzschlag discloses the claimed limitations as stated in claim 1 further including the step of displaying the interactive instructions on a translucent overlay bar (page 75 - column 1: lines 19-25; page 76 - Figure).

With respect to dependent claim 7:

Holzschlag discloses the claimed limitations as stated in claim 1. Even though Holzschlag does not explicitly disclose coupling the digital imaging device to the Internet, it is obvious that the image used by Holzschlag teaching needs a digital imaging device. However, Parulski et al. disclose the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the digital imaging device in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40); and

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e) making the HTML file available via the Internet by hosting a web server application on the digital imaging device (page 76 - column 1: lines 23-30).

With respect to independent claim 8:

Holzschlag disclose a method for generating an Internet page description file including images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose that the image is captured by the digital imaging device includes a display. It is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer. However, Parulski et al. disclose the image is captured by a digital imaging device having a display and a computer (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the image captured by a digital imaging device, the digital imaging device having a display and a computer system in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including digital imaging device having a display and a computer because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

the method comprising the steps of:

a) allowing a user to load a script onto the digital imaging device the script comprising a set of program instructions (page 75 - column 1: lines 20-25)

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b) executing the script to display interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 26-34);

c) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a series of related image captures to obtain a series of resulting images (page 75 - column 1: lines 19-34; column 2: lines 20-34); and

d) generating an HTML (hypertext markup language) file including the resulting images, wherein the HTML file is formatted in accordance with a predefined model included in the script, such that a formatted HTML file is automatically generated by the digital imaging device (page 76 - column 1: lines 1-34).

Even though Holzschlag does not explicitly disclose allowing the user to the digital imaging device to the Internet, it is obvious that the image used by Holzschlag teaching needs a camera. However, Parulski et al. disclose the camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40); and

f) making the Internet page description file available via the Internet by hosting a web server application on a computer system within the digital imaging device (page 75 - column 1: lines 19-25).

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With respect to dependent claim 9:

Claim 9 has been canceled per the Amendment filed on 03/20/2000.

With respect to dependent claim 10:

Holzschlag discloses the claimed limitations as stated in claim 8 wherein step a) further includes the step of providing the script as a text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 11:

Holzschlag discloses the claimed limitations as stated in claim 10 wherein step b) further includes the step of executing the script by the computer system interpreting the text-based script (Page 75 - column 1: lines 20-34).

With respect to dependent claim 12:

Holzschlag discloses the claimed limitations as stated in claim 11 step c) further includes the step of prompting the user for specific information, and entering the specific information on a text entry screen (page 75 - column 25-34).

With respect to dependent claim 13:

Holzschlag discloses the claimed limitations as stated in claim 12 wherein the Internet page description file is a hypertext markup language file (page 76 - column 1: lines 23-30).

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With respect to independent claim 14:

Holzschlag disclose a system for generating a formatted document including text and images (page 75; column 1: lines 1-34; column 2: lines 19-34). Even though Holzschlag does not explicitly disclose a hand held digital imaging device including a display, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display. However, Parulski et al. disclose a hand held digital imaging device including a display (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include a hand held digital imaging device including a display in the system of Holzschlag .

The skilled person would have been motivated to modify Holzschlag 's system by including hand held digital imaging device including a display because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

a) displaying interactive instructions on the display that prompt a user to perform specific operations (page 75 - column 1: lines 20-25);

b) in response to the user performing the specific operations, automatically updating the interactive instructions, such that the user is guided through a sequence of the interactive instructions adapted to capture information from the user (page 75 - column 1: lines 20-34);

d) transferring the information captured from the user to a formatted document, wherein the formatted document is formatted in accordance with a predefined model included in the script

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(page 75 - column 1: lines 20-34), Even though Holzschlag does not explicitly disclose such that the formatted document is automatically generated by the digital imaging device, it is obvious that the image used by Holzschlag teaching needs a digital imaging device having a display and a computer to format the document. However, Parulski et al. disclose a such that the formatted document is automatically generated by the digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include formatted documenting is automatically generated by the digital imaging device in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including the formatted document which is automatically generated by the digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

With respect to dependent claim 15:

Holzschlag discloses the claimed limitations as stated in claim 14 wherein step a) further includes providing a sequence of interactive instructions for a directed image capture, wherein the script prompts the user through a series of related image captures resulting in a plurality of stored images (page 75 - column 1: lines 19-25; page 76 - Figure). Again the rationale behind capture an image is explained in claim 14.

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With respect to dependent claim 16:

Holzschlag discloses the claimed limitations as stated in claim 14 wherein step a) further includes the step of providing the program instructions as a text-based script (Page 75 - column 1: lines 20-34). Even though Holzschlag does not explicitly disclose digital imaging device, it is obvious that the image used by Holzschlag teaching needs a digital imaging device. However, Parulski et al. disclose a digital imaging device (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include digital imaging device in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including digital imaging device because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65).

With respect to dependent claim 17:

Holzschlag discloses the claimed limitations as stated in claim 14, wherein the predefined model comprises the set of programming instructions which determine the formatted appearance of the document (page 75 - column 1: lines 19-34; page 76 - Figure).

With respect to dependent claim 18:

Holzschlag discloses the claimed limitations as stated in claim 17, wherein the predefined model is predefined in accordance with a particular purpose of the script such that the formatted

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document has an appearance in accordance with the particular purpose (page 75 - column 1: lines 19-34; column 2: lines 20-34; page 76 - column 1: lines 1-34).

With respect to dependent claim 19:

Holzschlag discloses the claimed limitations as stated in claim 14, wherein the document is an Internet page description file which defines a web page (page 75 - column 1: lines 19-34; column 2: lines 20-34; page 76 - column 1: lines 1-34).

With respect to dependent claim 20:

Holzschlag discloses the claimed limitations as stated in claim 19. Even though Holzschlag does not explicitly disclose coupling the digital camera to the Internet, it is obvious that the image used by Holzschlag teaching needs a camera. However, Parulski et al. disclose the camera (Abstract; Fig. 1; column 2: lines 51-65)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to include the camera in the system of Holzschlag.

The skilled person would have been motivated to modify Holzschlag's system by including a camera because such modifications would enable the user to select a category and download images (Parulski et al: column 2: lines 60-65; column 4: lines 23-40).

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Response to Amendment

8. Applicant's arguments filed 03/20/2000 have been fully considered but they are not persuasive. The Amendment is insufficient to overcome the prior art of record.

9. With respect to claims 1, 8, and 14 applicant argues that Molly E. Holzschlag (Laura Lemay Series Editor; Copyright 1997 by Sams net Publishing) in view of Parulski et al. (US Patent Number 5,633,678) fail to overcome the problem solved by present invention. The examiner respectfully disagrees as the amended claims to include the "digital imaging device" and cancel "camera". A "camera" is and could be a "digital imaging device", and in the Molly E. Holzschlag (Laura Lemay Series Editor disclose creating a series of individual graphics, either GIFs or JPGs. It obvious and well known in the art that they are created and captured by a "digital imaging device". Also applicant argues that the user must form a series of burdensome manual steps. Holzschlag, and Parulski et al. do not mention that the steps are manual, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to not to include a series of burdensome manual steps. The same rational holds true for amended claims 1 and 14 to cancel references to "a script". Parulski et al. clearly stated, and clearly disclose using digital image data.

Applicant argues that as stated in the background of the invention "the problem with the prior methods As the information must be entered, the user needs to remember the relevant details about each picture", also applicant argues that the user would still face these problems. The examiner respectfully disagrees as the this method and system are normally done as

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described by the applicant for generating an HTML file including images captured by a digital imaging device. The examiner respectfully state that the applicant failed to spell out in the claims (claim) the specifics novelty of the present invention

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wasseem Hamdan whose telephone number is (703) 305-3968. The examiner can normally be reached Monday-Thursday from 700AM-400PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on (703) 305-4713.

The fax phone number for this Art Unit is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Receptionist at (703) 305-3800.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry, please label

"FORMAL" and sign as attorney of record)

Or:

(703) 305-9724 (for informal or draft communications, please label "PROPOSED"

or "DRAFT" and prominently label PLEASE DELIVER DIRECTLY TO

EXAMINER)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Wasseem H. Hamdan

WH

March 31, 2000


STEPHEN S. HONG
PRIMARY EXAMINER